

Docket No.: 00-8024 RCE1

REMARKS**BEST AVAILABLE COPY****I. Introductory Comments**

The Office Action includes new grounds for rejecting claims 1-14, 16, 18-24, and 26-30 of the present application. In particular, the Examiner rejected: (1) claims 1-5, 8-12, 16, 21-24, and 30 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0137945 (hereinafter "Takagi") in view of U.S. Patent No. 6,529,602 (hereinafter "Walker"); (2) claims 6 and 13 under 35 U.S.C. §103(a) as being obvious over the combination of Takagi and Walker in further view of U.S. Patent Application Publication No. 2002/0160751 (hereinafter "Sun"); and (3) claims 7, 14, 18-20, and 26-29 under 35 U.S.C. §103(a) as being unpatentable over Takagi combined with Walker, U.S. Patent Application Publication No. 2003/0032447 (hereinafter "Bulthuis"), U.S. Patent No. 5,524,137 (hereinafter "Rhee"), and Sun and in further view of U.S. Patent No. 6,072,860 (hereinafter "Kek").

In this Amendment, Applicants have amended claims 1, 7, 8, 14, 22, and 26 by simply moving elements of dependent claims 7, 14, and 26 to independent claims 1, 8, and 22, respectively. No new matter has been introduced. Entry and consideration of these amendments are proper under 37 C.F.R. § 1.116 at least for the following reasons. The present amendments make only those changes necessary to place the application in condition for allowance, and the amendments do not raise new issues requiring further search or consideration. Therefore, entry of the present amendments is proper under 37 C.F.R. § 1.116 and is hereby requested.

After entry of the amendments, claims 1-14, 16, 18-24, and 26-30 will remain pending in the application. Claims 1, 8, and 22 are in independent form. Applicants respectfully request reconsideration of the currently pending claims in light of the amendments and remarks provided herein.

II. Patentability of Independent Claims 1, 8, and 22 as Amended

In this Amendment, Applicants have amended independent claim 1 to include, among other limitations, the following limitations:

...a user interface configured to allow a user of the wireless communication device to access, by way of a wireless network, the two-way conversation data stored in the remote storage device, the user interface including a plurality of data management functions that allows the user of the wireless communication device to manage, by way of the wireless network, the two-way conversation data stored in the remote storage device, the

Docket No.: 00-8024 RCE1

plurality of data management functions including functions for editing and translating the two-way conversation data stored in the remote storage device.
(Emphasis added.)

Independent claims 8 and 22 have been amended to include similar limitations directed to translating two-way conversation data in a storage location. The limitations directed to functions for translating two-way conversation data were previously recited in dependent claims 7, 14, and 26. Accordingly, the grounds relied upon by the Examiner to reject these claims are relevant.

On page 8 of the Office Action, the Examiner relied upon the combination of five different references to reject claims 7, 14, and 26 under 35 U.S.C. §103(a). With respect to the limitations directed to functions for translating two-way conversation data, the Examiner admits that the combination of Takagi, Walker, and Bulthuis "fails to teach translating the audio data stored in the storage location." Page 9 of the Office Action. The Examiner then asserts that Rhee teaches these limitations and that combination of Rhee with Takagi, Walker, and Bulthuis would have been obvious to one of ordinary skill in the art because the combination would improve flexibility "by allowing English, Spanish, French, German, Japanese and Chinese users to access the same audio data." Page 9 of the Office Action.

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)." M.P.E.P. § 2143.01. Thus, a *prima facie* case of obviousness requires: (1) a suggestion or motivation to modify or combine the reference teachings; (2) a reasonable expectation of success; and (3) a teaching or suggestion in the prior art references of all of the claim limitations (MPEP 2143). For at least the reasons discussed below, the Office Action does not satisfy all of these requirements.

A. Improper combination of Rhee with Takagi, Walker, and Bulthuis

The Office Action fails to establish a *prima facie* case of obviousness because one of ordinary skill in the art would not have been motivated to combine Rhee with Takagi, Walker, or Bulthuis as asserted by the Examiner of page 9 of the Office Action. While

Docket No.: 00-8024 RCE1

Takagi, Walker, and Bulthuis are directed to recording the content of two-way telephone calls, Rhee is limited to recording and translating one-way voice communications commonly referred to as voicemail messages. Rhee teaches that a voicemail message left by a user can be translated to a selected language, such as the language of the intended recipient of the message. Col. 1, lines 10-33; col. 3, lines 6-12; and col. 4, lines 12-14 of Rhee. This allegedly allows users of different language backgrounds to communicate through translated one-way voicemail messages. Thus, Rhee is directed to using voicemail translation to allow users of different languages to communicate using one-way messages, which solution is unrelated to the storing and managing of two-way conversation data. Accordingly, one of ordinary skill in the art having read Takagi, Walker, or Bulthuis and noting deficiencies therein would not have been motivated to look to the one-way voicemail translation system of Rhee to cure the noted deficiencies. Moreover, Rhee teaches away from a combination of Rhee with Takagi, Walker, and Bulthuis because voicemail communications between two persons of different language backgrounds as disclosed in Rhee teaches away from two-way conversations. Indeed, two persons of different language backgrounds cannot readily talk to each other. Therefore, the alleged combination of Rhee with Takagi, Walker, and Bulthuis would not have been obvious to one of ordinary skill in the art.

B. The prior art of record fails to teach or suggest all claim limitations

The Office Action fails to establish a *prima facie* case of obviousness against amended independent claims 1, 8, and 22 for a separate and independent reason: the prior art of record, taken either alone or in combination, does not teach or suggest the claim limitations directed to a user interface providing a data management function configured to allow a user of a wireless communication device to translate, by way of a wireless network, two-way conversation data stored in a remote storage device. The Examiner correctly admits that Takagi, Walker, and Bulthuis fail to teach or suggest translating stored audio data. Page 9 of the Office Action. Sun and Kek also clearly fail to teach or suggest a function for translating audio data.

Although Rhee teaches a feature for changing the language of an outputted message to be different from the language of a stored message (Abstract of Rhee), Rhee does not teach or suggest a function for translating two-way conversation data in a storage location as respectively recited in claims 1, 8, and 22. In contrast, Rhee is limited to translating one-way voicemail audio messages. In particular, Rhee teaches that when a user is leaving a message

Docket No.: 00-8024 RCE1

with the system of Rhee, the user may select whether to translate the message to another language, such as the language of the intended recipient. Col. 3, lines 6-12 and col. 4, lines 12-14 of Rhee. Thus, Rhee is limited to translating one-way voicemail messages and does not teach or suggest translating two-way voicemail messages.

The combination of Rhee with Takagi, Walker, and Bulthuis asserted by the Examiner also fails to teach or suggest translating two-way conversation data in a storage location. Because Rhee is limited to translating one-way voicemail message, there is no teaching or suggestion of the translation service of Rhee being able to translate two-way conversation data. Therefore, the combination of Takagi, Walker, Bulthuis, and Rhee asserted by the Examiner fails to teach or suggest the claim limitations directed to functions for translating two-way conversation data in a storage location.

For either of the foregoing reasons, independent claims 1, 8, and 22 as amended recite subject matter that is patentable over the prior art of record. Therefore, Applicants respectfully request that the Examiner withdraw the rejections of these claims, as well as the rejections of claims 2-7, 9-14, 16, 18-21, 23, 24, and 26-30, which depend from independent claims 1, 8, and 22, respectively.

III. Patentability of the Dependent Claims

Claims 2-7, 9-14, 16, 18-21, 23, 24, and 26-30 are in condition for allowance by way of their respective dependencies from independent claims 1, 8, and 22. In addition, the dependent claims recite independently patentable subject matter. Merely by way of example, the Examiner relied upon the combination of five different references to reject claims 7, 14, 18-20, and 26-29. The combination of five references alone is evidence that one of ordinary skill in the art would not have been motivated to combine the references as asserted by the Examiner. "[I]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, (Fed. Cir. 1992). Piecemeal combination of the references is especially impermissible when the references are directed to disparate solutions. Thus, the divergent nature of the problem addressed by Rhee as compared to the problems addressed by Takagi, Walker, and Bulthuis teaches away from the combination of the references, as discussed above, and one of ordinary skill in the art would not have been motivated to combine Takagi, Walker, Bulthuis, Rhee, Sun, and Kek as asserted by the Examiner. Therefore, the Office Action fails to establish a *prima facie* case of

Docket No.: 00-8024 RCE1

obviousness against claims 7, 14, 18-20, and 26-29, and the rejection of these claims should be withdrawn.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue. It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 07-2347. To the extent necessary, a petition for extension of time under 37 C.F.R. 1.136 is hereby made, the fee for which should be charged to the above account number.

Respectfully submitted,

Dated: November 21, 2005

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